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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,506	11/22/2000	Thomas R. Cech	015389-002616US	5211

34151 7590 09/07/2006

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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/721,506	CECH ET AL.	
	Examiner	Art Unit	
	Bradley L. Sisson	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-78,80,102 and 105-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-78,80,102 and 105-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>27 July 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 27 July 2006 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed on 25 August 2006 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patents 6,927,285 and US Patent 6,337,200 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 75-78 and 105-108 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/054,295. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims fairly encompass nucleic acid that encodes hTERT.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 75-78 and 105-108 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-26, 69, 70, 81, and 82 are of copending Application No. 09/721,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to polynucleotide/nucleic acid that encodes hTERT.

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9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 75-78 and 105-108 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 19, and 21-23 of copending Application No. 10/044,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to an isolated nucleic acid. While the claimed composition of claim 1 in the '692 application is defined as being "an immunogenic composition," it need only comprise the nucleic acid. Accordingly, claims drawn to a nucleic acid or to a composition that comprises same, when only are obvious one over the other.

11. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 75-78 and 105-108 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 9-14, and 23-25 of copending Application No. 10/877,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims fairly encompass isolated nucleic acid that encodes hTERT.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 75-78 and 105-108 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,475,789. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '789 patent render obvious nucleic acids that encode the now claimed nucleic acid and cells that comprise same.

15. Claims 75-78 and 105-108 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,261,836. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '836 patent are drawn to nucleic acid that encodes TRT and cells that comprises same, as are the present claims. Accordingly, the aspect of claiming nucleic acids that encode TRT would have been obvious, as would have the development of cells that comprise same.

16. Claim 75 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,093,809. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '809 patent is drawn to isolated nucleic acid that encodes TRT.

17. Claims 75-78 and 105-108 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 and 18 of U.S. Patent No. 6,767,719. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '719 patent encompass not only the disclosed sequence but that which is 90% similar to it as well as cells that comprise same. Given such disclosure, it would have been obvious to one of ordinary skill in the art to develop the now-claimed nucleic acids that encode TRT, as well as cells that comprise said polynucleotide.

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Conclusion

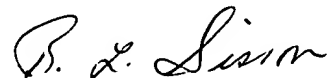
18. Objections and/or rejections which appeared in the prior Office action and which have not been repeated hereinabove have been withdrawn.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751.

The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Bradley L. Sisson
Primary Examiner
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BLS